

Application No. 10/803,182  
Response dated Friday, May 19, 2006  
Submitted by Louis J. Franco, USPTO Reg. 38,885

Transmitted via facsimile to (571) 273-8300  
Reply to Office Action of March 2, 2006  
Attorney Phone: 978-582-5550

## **REMARKS/ARGUMENTS**

### **In re amendments to the specification**

The final paragraph of the summary has been amended to express in terms more closely paralleling terms now included in some of the claims subject matter that was already expressed in other terms, and clearly supported in the drawings, in the application as filed.

### **In re the objection(s) to the drawings**

In her Office Action of March 2, 2006, the Examiner objected to the drawings under 37 CFR 1.83(a) or, in the alternative, claims including features not shown in the drawings. More specifically, the Examiner noted "[t]he drawings must show every feature of the invention specified in the claims . . . (and) . . . the hook-and-swingbolt fastener system being used in an ocean-going vessel or an aircraft or a railroad engine . . . must be shown or the feature(s) canceled from the claims. In response to this objection, the Applicants' Attorney has canceled the claims that included references to features not shown in the drawings.

### **In re rejections under Section 102 for anticipation by Lee (U.S. Pat. 1,872,471)**

In the Office Action mailed March 2, 2006, the Examiner rejected under 35 U.S.C. 102(b) original claims 1 and 2 as being anticipated by US Patent No. 1,872,471 to Lee (hereinafter, the '471 patent or "Lee"). In responding to this basis of rejection, Applicants' Attorney notes that original claim 4, which depended directly from claim 1, was rejected under Section 103(a) as being unpatentable over Lee in view of Wright (Office Action, paragraph 7, page 5). Claim 1 has been amended to include the limitations of both of original claims 1 and 4. Accordingly, based on the Examiner's

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assessment of claim 4, amended claim 1 is not rejectable under Section 102(b). Moreover, because original claim 2 depends from amended claim 1, Section 102(b) is now no longer at issue as a basis for rejection of claim 2. Accordingly, all remaining bases of rejection to be addressed are those under Section 103(a).

**In re rejections under Section 103 over Lee in view of Wright (U.S. Pat. 3,212,746)**

**Amended claim 1 and original claims 2, 6 and 7**

Referring again to page 5, paragraph 7 of the Examiner's Action, the Examiner rejected original claims 3, 4, 8-11, 15-18 and 20 under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Wright. More specifically, the Examiner stated:

"Lee discloses a swingbolt hook having all of the limitations listed above for rejections of claims 1 and 2. Lee does (*not?*) disclose that the swingbolt hook has a first surface that is convex and a second surface that is concave. However, Wright teaches a swingbolt hook (26). The hook comprises a base (25) and a swingbolt catch (28). . . The swingbolt catch depends from the base and has base and distal ends and first and second opposed surfaces (FIG. 5). . . . The first and second surfaces being oriented to one another such that, as viewed into a . . . second cross-sectional plane passing through the first and second surfaces and the left and right sides of the swingbolt catch, at least one of (i) the first surface of the swingbolt catch is convex and (ii) the second surface of the swingbolt catch is concave (FIG. 5). . . Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to have a swingbolt catch . . . (*in which*). . . at least one of (i) the first surface of the swingbolt catch is convex and (ii) the second surface of the swingbolt catch is concave as taught by Wright in the hook disclosed by Lee.

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*(selected emphasis added)*

Because amended claim 1 essentially includes the limitations of original claims 1 and 4, Applicants' Attorney addresses the Section 103(a) basis of rejection first with respect to amended claim 1 for a swingbolt hook adapted for cooperative coupling engagement with a swingbolt.

To begin, despite the Examiner's assertions at the beginning of paragraph 4 (page 3) and paragraph 7 (page 5) that Lee discloses a swingbolt hook, the invention of Lee is further outside the realm of hook-and-swingbolt fastener systems than it at first appears. More specifically, Lee's patent relates to a fastening means for securing the hoods of motor vehicles. Although, in rejecting claims 1 and 2 in paragraph 4, the Examiner never specifically identifies by reference number what in Lee she considers to be the swingbolt portion in Lee to Lee's "swingbolt hook 13," context and logic dictate that it can only be element 8. Lee describes the nature of element 8 in relevant part in the following excerpts:

"In my improved construction the hood fastening means is preferably molded as an integral unit from an elastic substance such as rubber, in order that the fastener will not become noisy and rattle regardless of the amount of wear to which it is subjected."

(Lee, column 1, lines 36 to 41, emphasis added)

"Means are provided for holding down the hood 7 to the frame of the car and comprises an elongated elastic non-metallic element 8, preferably molded from rubber or like substance"

(Lee, column 1, lines 45 to 50, emphasis added)

"The upper end of the fastening element 8 is provided with an inwardly and upwardly extending recess 12 for receiving and embracing an outwardly and upwardly projecting horn or lug 13, which is . . . secured to the hood 7.

The end of the element 8 is provided with an eye 14, through which a finger of the user may be inserted for aiding in the manipulation when hooking it on or unhooking it from the lug 13.

(Lee column 2, lines 57 to 67)

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"In the use of this improved fastener, the finger of the user is passed through the eye 14 and due to the elasticity of the element (8) it may be stretched upwardly sufficiently to hook the hood lug 13 into the recess 12.

(Lee column 2, lines 76 to 80, emphasis added)

By Lee's own description, several aspects distinguishing his fastener from that of the Applicants are clear. First, although element 8 may appear upon examination of FIG. 3 to be a metal, or at least a rigid, fastener of some type adapted to selectively engage the lug 13, Lee makes clear that element 8 is elastic by design and that the functionality of his fastener depends upon the elasticity of element 8. By contrast, the element of Applicants' invention equated to Lee's elastic element 8 is an externally threaded rod carrying a hook catch and threaded nut, which rod can, at least by strong implication, only be rigid in order to support threadable engagement by a nut. In Lee, the fastening force is provided by the restorative force imparted to the element 8 when it is stretched, while in the Applicants' invention, the application of force onto the swingbolt catch is by threadable advancement of Applicants' nut about the threaded rod and depends upon the rigidity of the elongated threaded rod. Accordingly, it is clear that Lee does not relate to rigid fastener systems, let alone the more specific class of rigid fastener systems known as "swingbolts." While it is true that claim 1 does not itself claim the "bolt portion" of a swingbolt system, the claim does make clear that the hook being claimed is one adapted for coupling engagement with a swingbolt and, therefore, brings into question the suitability of Lee as a proper Section 103(a) reference that one of ordinary skill in the art attempting to improve swingbolts would be moved to consult at the time of Applicants' invention and in the absence of Applicants' disclosure.

Applicant's Attorney respectfully disagrees with the Examiner's assertion of obviousness concerning the combination of Wright and Lee on two grounds, either of which is sufficient to indicate the withdrawal of the rejection under Section 103(a). As the Examiner is undoubtedly well aware, in order for prior art to be considered relevant to the patentability of a claim under examination, the prior art must be within the purview of Section 103 and the prior art either must be in the field of the inventor's endeavor, or

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it must be reasonably pertinent to the particular problem with which the inventor was involved. *In re Deminski*, 796 F.2d 436 (Fed. Cir. 1986). While Applicants' Attorney acknowledges that, where a reference is outside the precise field of endeavor to which the invention relates, resort may be had to "analogous" prior art under Section 103, "analogous" prior art is that which, though not in the field of the inventor's endeavor, is in a field which a person of ordinary skill would reasonably have consulted and applied when addressing the problem the inventor was trying to solve. *In re Deminski*. For the reasons explained above in connection with the structure and workings of Lee's fastening system as compared to Applicants' fastening system, Applicants' Attorney submits that, not only is Lee not within the Applicants' field of endeavor, it is, as previously alluded to, not a reference that one of ordinary skill acting reasonably would have consulted in seeking to solve the problems that the current Applicants have solved. These observations, in combination with the principle espoused in *Pentec, Inc. v Graphic Controls Corp.*, 776 F.2d 309 (Fed. Cir. 1985) that it is improper to collect prior art with the claimed invention in mind, indicate that withdrawal of the rejection of the combination of original claims 1 and 4 as currently embodied in amended claim 1 is proper.

In addition to Lee's being a reference that, we submit, is not one that a person of ordinary skill acting reasonably would have consulted, there is lacking in the Wright and Lee references themselves any suggestion of the desirability of their combination as proposed by the Examiner. There must be some supporting teaching in the prior art for the proposed combination of references to be proper. *In re Newell*, 891 F. 2d 899 (Fed. Cir. 1989). If the prior art provides no teaching, suggestion or incentive supporting the combination proposed by the Examiner, the rejection is in error and must be reversed. *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990). To imbue one of ordinary skill in the art with knowledge of the invention . . . when no prior art reference or references of record convey or suggest that knowledge is to fall victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1988).

Compelling evidence from which it may be reasonably inferred that either or both

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(i) one of ordinary skill in the art acting reasonably would not have consulted Lee to solve the problem with which the current Applicants were faced or (ii) that nothing in Lee or Wright suggests a combination with the other in the manner proposed by the Examiner is the length of time that those of skilled in the art have had access to both Lee and Wright. More specifically, in the first instance, Wright filed for letters patent more than 32 years after Lee, yet Wright did not incorporate into his swingbolt any aspect of Lee now regarded as relevant. Perhaps more importantly, however, is that no person of ordinary skill or otherwise thought to combine the teachings of Lee and Wright in the manner proposed by the Examiner despite the fact that both Wright and Lee were generally available as references for more than 38 years prior to the current Applicants' filing date. These facts, taken in combination with the stated advantages of Applicants' swingbolt hook, weigh strongly in favor of withdrawal of the rejection under Section 103 of amended claim 1 (i.e., the combination of original claims 1 and 4).

Original dependent claims 3 through 5 have been canceled and are no longer at issue in the case.

Independent claim 8 is retained in the case and includes minor amendments that remove the sub-clause numbering (i), (ii), (iii) and (iv) under clause (a) for the swingbolt portion of the claimed fastener system. Also, underlining after the removal brackets has been added to signify that space should be added such that, the indenting of the first line of each sub-clause previously numbered (i), (ii), (iii) or (iv) is indented to the same extent and in analogous fashion to the indenting of the sub-clauses of clause "b." Moreover, in the concluding "wherein clause," the wording "capable of being" is added so that claim 8 now concludes with " . . . the swingbolt catch and hook catch are capable of being drawn into retaining engagement." Applicants' Attorney submits that claim 8 is allowable for the reasons articulated for substantially same reasons advanced above for the allowability claim 1 and, furthermore, for the reason that claim 8 is drawn not just to a hook, but to an entire hook-and-swingbolt fastener system. The fastener system of claim 8 arguably includes features taught in the combination of Wright and Lee, but, as previously explained in connection with claim 1, Lee is not a reference to which one of ordinary skill in the art at the time of Applicants' invention would have

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looked to solve the swingbolt-related problems that the inventors have solved.

Claim 9 through 11 add narrowing features to base claim 8 and, therefore, are allowable for at least the reason that they depend from an allowable base claim.

Original claims 15-18 and 20 were rejected under Section 103(a) as being unpatentable over Lee in view of Wright. However, claims 15-18 and 20 have been canceled and are no longer at issue in the case.

New independent claim 21 includes, essentially, the limitations of currently-amended claim 8 and original claim 10. In new claim 21, the swingbolt catch tapers so as to become thicker with increased proximity to the base and "as viewed into a second cross-sectional plane passing through the first and second surfaces and the left and right sides of the swingbolt catch, at least one of (a) the first surface of the swingbolt catch is convex and (b) the second surface of the swingbolt catch is concave." Accordingly, based on the reasons submitted for allowance of claim 8, in addition to the fact the new claim 21 includes a further limitation, it is submitted that new claim 21 is allowable. New dependent claims 22 through 24 add limitations to allowable base claim 21 and are, therefore, allowable even if only by virtue of their dependence upon an allowable base claim.

Rejection of claims 5, 6, 7, 12-14 and 19 in view of Shimizu

Each of claims 5, 6, 7, 12-14 and 19 were rejected in view of Shimizu, as explained in paragraphs 6 and 8 of the Examiner's Action. As previously indicated, claim 5 has been canceled. Each of original claims 6, 7, 12-14 and 19 is drawn to a swingbolt hook that is at least partially coated with a wear-resistant coating and is retained in the case as originally filed (i.e., without amendment). We need not specifically address whether each of claims 6, 7, 12-14 and 19 actually adds any patentable feature as each is dependent upon a claim the patentability of which has been argued for above. Accordingly, it is respectfully requested that the Section 103 rejections of claims 6, 7, 12-14, and 19 be withdrawn.

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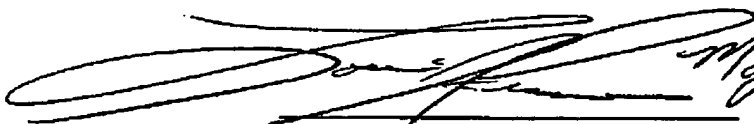
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In light of the foregoing remarks/arguments, Applicants' Attorney respectfully submits that all claims now in the case are allowable and requests that a timely Notice of Allowance be issued. Moreover, although in various instances, Applicants' Attorney refers to dependence upon an allowable base claim as a basis for supporting the allowability of a dependent claim, in no instance does this observation constitute an admission that such dependence is the only basis upon which a dependent claim to which the argument is applied is patentably distinct from the art cited against it.

#### NO FEES DUE

Because this response is being filed on or before the non-extended deadline of June 2, 2006, no extension fees are due. Furthermore, three independent claims, and 15 total claims, are now pending in the case; therefore, no extra-claim fees are due.

Respectfully submitted,

  
May 19, 2006

Louis J. Franco  
USPTO Registration No.: 38,885  
Attorney for Applicant  
Law Office of Louis J. Franco - Lunenburg  
250 Arbor Street  
Lunenburg, Massachusetts 01462  
Phone: (978) 582-5550  
Fax: (978) 582-9022



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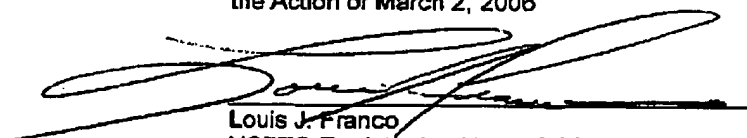
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Louis J. Franco  
USPTO Registration No.: 38,885  
Attorney for Applicant  
Date of this Signature: Friday, May 19, 2006

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